REMARKS

This is a full and timely response to the outstanding final Office Action mailed October 19, 2005 (Paper No/Date 20051011). Through this response, claims 1 and 32 have been amended. Claims 1-56 remain pending in the present Application. Reconsideration and allowance of the Application and pending claims are respectfully requested.

I. Examiner Interview

Applicants sincerely appreciate the time that Examiner Laye spent with Applicants' Attorney Dennis Jones in a telephone conversation on December 14, 2005. During that conversation Examiner Laye seemed to indicate that it might be beneficial to include the amendments contained herein. More specifically, Examiner Laye seemed to agree that the *Berstis* reference, cited herein, appears to teach receiving downloaded recordable media content, followed by user request to store the downloaded recordable media content to alternate media, followed by storage of the downloaded recordable media content to alternate media. Thus, Applicants respectfully request careful consideration of this response and the amendments recited herein.

II. Claim Rejections - 35 U.S.C. § 102(e)

A. Statement of the Rejection

Claims 1-4, 32, 46, 47, and 56 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,564,005 to Berstis, hereinafter referred to as *Berstis*. Applicants respectfully traverse this rejection on the grounds that *Berstis* does not disclose, teach, or suggest all of the claimed elements. Applicants have amended claim 1 and claim 32, and thus the discussion below addresses the Office Action arguments in the context of the claim amendments.

B. Discussion of the Rejection

For a proper rejection of a claim under 35 U.S.C. § 102(e), the cited reference must disclose all elements, features, and steps of the claim. *See e.g., E.I. du Pont de*

Nemours & Co. v. Phillips Petroleum Co. , 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988) (emphasis added). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e). In the present case, not every feature of the claims is represented in the *Berstis* reference.

Independent Claim 1

Independent claim 1, as amended, recites:

> 1. A recordable media content archiving system in a subscriber network, said recordable media content archiving system comprising:
> a memory for storing recordable media content characterizing information;
> a storage device for storing a plurality of portable mediums; and
> a processor configured with the memory to receive the recordable media content characterizing information into the memory, wherein the processor is further configured to provide a user interface for the recordable media content archiving system, ***wherein the processor is further configured to receive downloaded recordable media content characterizing information and downloaded recordable media content and to concurrently store the downloaded recordable media content into at least one of the portable mediums according to a processor determined correlation of the downloaded recordable media content characterizing information and characterizing information corresponding to the at least one of the portable mediums.***
>
> *(Emphasis added.)*

Independent claim 1 is allowable over *Berstis* for at least the reason that *Berstis* does not disclose, teach or suggest the features that are highlighted in independent claim 1 above. More specifically, *Berstis* does not disclose, teach or suggest that a processor is "configured to receive downloaded recordable media content characterizing information and downloaded recordable media content and to concurrently store the downloaded recordable media content into at least one of the portable mediums according to a processor determined correlation of the downloaded recordable media content

characterizing information and characterizing information corresponding to the at least one of the portable mediums," as recited in independent claim 1.

It is asserted in the Office Action that *Berstis*

> ... allows the user to specify the channel, day, and time period (*i.e.*, characterizing info of medium). Once all characterizing info has been identified by the system, the corresponding program is recorded and downloaded onto the medium specified by the user.
>
> *Office Action, p. 3.*

Applicants respectfully disagree with this characterization of the *Berstis* reference.

Berstis appears to teach a "video hard disk recorder system and method ***for recording and storing television programs on a hard disk*** for later viewing by users." *Berstis, column 6, lines 23-25. (Emphasis added.)* Further, *Berstis* appears to teach saving the "stored television program to an alternate medium" **after** the program has been saved on the hard disk. *Berstis, column 10, lines 56-57.* Specifically, *Berstis* recites:

> The system then displays the user's Play List, displaying all available ***programs that have been saved onto the hard disk*** for the user (step 764). The user selects a television program to save (step 768). The system prompts the user for the type of medium (e.g., videocassette tape, compact disk, DVD, etc.) (step 770), and the user selects the desired medium (step 772). ... The system ***then saves*** the selected television program to the selected medium....
>
> *Berstis, column 10, line 66 - column 11, line10. (Emphasis added.)*

As indicated above, *Berstis* appears, *arguendo*, to teach saving programs onto a hard disk and the ability for a user to transfer the saved programs to an alternate medium, and the capability to transfer the saved programs occurs after the recording. There appears to be no discussion regarding the capability to download "recordable media content and to concurrently store the downloaded recordable media content" into portable mediums.

Applicants respectfully submit that since *Berstis* does not anticipate independent claim 1, as amended, claim 1 is in condition for allowance and the rejection should be withdrawn.

Further, Applicants respectfully submit that because independent claim 1 is allowable, as argued above, dependent claims 2-4 are allowable as a matter of law for at least the reason that they contain all the elements, features and limitations of independent claim 1. *See In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of these claims be withdrawn.

Independent Claim 32

Independent claim 32, as amended, recites:

> 32. A method for archiving recordable media content, comprising the step of:
>
> providing a user interface for enabling a user ***to request a recordable media content download from a remote device for concurrent storage on at least one of a plurality of portable mediums located in a storage device***, wherein recordable media content characterizing information is correlated by a processor with at least one of a plurality of portable mediums based on portable medium characterizing information, wherein the user interface further enables the user to categorize the recordable media content and the portable mediums into a structured archive; and
>
> receiving and storing recordable media content characterizing information into a memory.

(Emphasis added.)

Independent claim 32 is allowable over *Berstis* for at least the reason that *Berstis* does not disclose, teach or suggest the features that are highlighted in independent claim 32 above. More specifically, *Berstis* does not disclose, teach or suggest "enabling a user to request a recordable media content download from a remote device for concurrent storage on at least one of a plurality of portable mediums located in a storage device," as recited in independent claim 32 above.

As argued above regarding claim 1, *Berstis* appears, *arguendo*, to teach saving programs onto a hard disk and the ability for a user to transfer the saved programs to an alternate medium, and the capability to transfer the saved programs occurs after the recording. There appears to be no discussion regarding the capability "to request a recordable media content download from a remote device for concurrent storage on at least one of a plurality of portable mediums located in a storage device."

Applicants respectfully submit that since *Berstis* does not anticipate independent claim 32, as amended, claim 32 is in condition for allowance and the rejection should be withdrawn.

Further, Applicants respectfully submit that because independent claim 32 is allowable, as argued above, dependent claims 46, 47 and 56 are allowable as a matter of law for at least the reason that they contain all the elements, features and limitations of independent claim 32. *See In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of these claims be withdrawn.

III. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 5-13, 16-25, 27, 29, 30, 33-42, 45, 48, 49, and 51-55

Claims 5-13, 16-25, 27, 29, 30, 33-42, 45, 48, 49, and 51-55 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Berstis* in view of U.S. Publication No. 2004/0128685 to Hassell, *et. al.*, hereinafter referred to as *Hassell*. Applicants respectfully traverse this rejection.

B. Discussion of the Rejection

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides

as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, Applicants respectfully submit that a *prima facie* case for obviousness has not been established.

Dependent Claims 5-13, 16-25, 27, 29 and 30

As described above, *Berstis* does not disclose the features of independent claim 1. Further, *Hassell* does not remedy the above-described deficiencies. More specifically, *Hassell* does not disclose, teach or suggest that a processor is "configured to receive downloaded recordable media content characterizing information and downloaded recordable media content and to concurrently store the downloaded recordable media content into at least one of the portable mediums according to a processor determined correlation of the downloaded recordable media content characterizing information and characterizing information corresponding to the at least one of the portable mediums," as recited in independent claim 1.

Hassell appears to teach allowing "**the user to transfer programs ... stored on digital storage device 49** to other volumes of digital storage device 49 or to secondary storage device 47...." *Hassell, paragraph 81, lines 1-4. (Emphasis added.)* The teaching, *arguendo*, appears to be the transfer of programs **stored**, or already recorded. There appears to be no discussion regarding the capability to download "recordable media content and to concurrently store the downloaded recordable media content" into portable mediums.

Thus the proposed combination of *Berstis* and *Hassell* fails to disclose, teach or suggest the features of independent claim 1. Because claims 5-13, 16-25, 27, 29 and 30

contain the features of independent claim 1, Applicants respectfully submit that claims 5-13, 16-25, 27, 29 and 30 are allowable as a matter of law.

In summary, it is Applicants' position that a *prima facie* case for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Berstis* in view of *Hassell* and that the rejection of these claims should be withdrawn.

Dependent Claims 33-42, 45, 48, 49 and 51-55

As described above, *Berstis* does not disclose the features of independent claim 32. Further, *Hassell* does not remedy the above-described deficiencies. More specifically, *Hassell* does not disclose, teach or suggest "enabling a user to request a recordable media content download from a remote device for concurrent storage on at least one of a plurality of portable mediums located in a storage device," as recited in independent claim 32 above.

Hassell appears to teach allowing "**the user to transfer programs ... stored on digital storage device 49** to other volumes of digital storage device 49 or to secondary storage device 47...." *Hassell, paragraph 81, lines 1-4. (Emphasis added.)* The teaching, *arguendo*, appears to be the transfer of programs **stored**, or already recorded. There appears to be no discussion regarding the capability "to request a recordable media content download from a remote device for concurrent storage on at least one of a plurality of portable mediums located in a storage device."

Thus the proposed combination of *Berstis* and *Hassell* fails to disclose, teach or suggest the features of independent claim 32. Because claims 33-42, 45, 48, 49 and 51-55 contain the features of independent claim 32, Applicants respectfully submit that claims 33-42, 45, 48, 49 and 51-55 are allowable as a matter of law.

In summary, it is Applicants' position that a *prima facie* case for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Berstis* in view of *Hassell* and that the rejection of these claims should be withdrawn.

C. Rejection of Claims 14, 15, 28, 43 and 44

Claims 14, 15, 28, 43, and 44 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Berstis* in view of *Hassell* and further in view of WO 92/22983 to Browne, *et al.*, hereinafter referred to as *Browne*. Applicants respectfully traverse this rejection.

Dependent Claims 14, 15 and 28

As described above, *Berstis* and *Hassell* do not disclose the features of independent claim 1. *Browne* does not remedy the above-described deficiencies. More specifically, *Browne* does not disclose, teach or suggest that a processor is "configured to receive downloaded recordable media content characterizing information and downloaded recordable media content and to concurrently store the downloaded recordable media content into at least one of the portable mediums according to a processor determined correlation of the downloaded recordable media content characterizing information and characterizing information corresponding to the at least one of the portable mediums," as recited in independent claim 1.

Browne appears to teach an "audio/video recorder system" and "reconfiguration of **stored programs**, and routing of **stored programs** to selected outputs." *Browne, Abstract. (Emphasis added.)* There appears to be no discussion regarding the capability to download "recordable media content and to concurrently store the downloaded recordable media content" into portable mediums.

Thus the proposed combination of *Berstis, Hassell* and *Browne* fails to disclose, teach or suggest the features of independent claim 1. Because claims 14, 15 and 28 contain the features of independent claim 1, Applicants respectfully submit that claims 14, 15 and 28 are allowable as a matter of law.

In summary, it is Applicants' position that a *prima facie* case for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Berstis* in view of *Hassell*, and further in view of *Browne*, and that the rejection of these claims should be withdrawn.

Dependent Claims 43 and 44

As described above, *Berstis* and *Hassell* do not disclose the features of independent claim 32. *Browne* does not remedy the above-described deficiencies. More specifically, *Browne* does not disclose, teach or suggest "enabling a user to request a recordable media content download from a remote device for concurrent storage on at least one of a plurality of portable mediums located in a storage device," as recited in independent claim 32 above.

Browne appears to teach an "audio/video recorder system" and "reconfiguration of **stored programs**, and routing of **stored programs** to selected outputs." *Browne, Abstract. (Emphasis added.)* There appears to be no discussion regarding the capability "to request a recordable media content download from a remote device for concurrent storage on at least one of a plurality of portable mediums located in a storage device."

Thus the proposed combination of *Berstis, Hassell* and *Browne* fails to disclose, teach or suggest the features of independent claim 32. Because claims 43 and 44 contain the features of independent claim 32, Applicants respectfully submit that claims 44 and 45 are allowable as a matter of law.

In summary, it is Applicants' position that a *prima facie* case for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Berstis* in view of *Hassell*, and further in view of *Browne*, and that the rejection of these claims should be withdrawn.

D. Rejection of Claims 26 and 50

Claims 26 and 50 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Berstis* in view of *Hassell*, and further in view of U.S. Patent No. 5,619,247 to Russo, hereinafter referred to as *Russo*. Applicants respectfully traverse this rejection.

Dependent Claim 26

As described above, *Berstis* and *Hassell* do not disclose the features of independent claim 1. *Russo* does not remedy the above-described deficiencies. More specifically,

Russo does not disclose, teach or suggest that a processor is "configured to receive downloaded recordable media content characterizing information and downloaded recordable media content and to concurrently store the downloaded recordable media content into at least one of the portable mediums according to a processor determined correlation of the downloaded recordable media content characterizing information and characterizing information corresponding to the at least one of the portable mediums," as recited in independent claim 1.

It is asserted in the Office Action that *Russo* discloses a "system whereby individual users have separate storage areas." Even if *Russo* discloses the asserted system, the above-described deficiencies of *Berstis* and *Hassell* are not remedied. There appears to be no discussion regarding the capability to download "recordable media content and to concurrently store the downloaded recordable media content" into portable mediums.

Thus the proposed combination of *Berstis, Hassell* and *Russo* fails to disclose, teach or suggest the features of independent claim 1. Because claim 26 contains the features of independent claim 1, Applicants respectfully submit that claim 26 is allowable as a matter of law.

In summary, it is Applicants' position that a *prima facie* case for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Berstis* in view of *Hassell*, and further in view of *Russo*, and that the rejection of these claims should be withdrawn.

Dependent Claim 50

As described above, *Berstis* and *Hassell* do not disclose the features of independent claim 32. *Russo* does not remedy the above-described deficiencies. More specifically, *Russo* does not disclose, teach or suggest "enabling a user to request a recordable media content download from a remote device for concurrent storage on at least one of a plurality of portable mediums located in a storage device," as recited in independent claim 32 above.

It is asserted in the Office Action that *Russo* discloses a "system whereby individual users have separate storage areas." Even if *Russo* discloses the asserted system, the above-described deficiencies of *Berstis* and *Hassell* are not remedied. There appears to be no discussion regarding the capability to download "recordable media content and to concurrently store the downloaded recordable media content" into portable mediums.

Thus the proposed combination of *Berstis, Hassell* and *Russo* fails to disclose, teach or suggest the features of independent claim 32. Because claim 50 contains the features of independent claim 32, Applicants respectfully submit that claim 50 is allowable as a matter of law.

In summary, it is Applicants' position that a *prima facie* case for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Berstis* in view of *Hassell*, and further in view of *Browne*, and that the rejection of these claims should be withdrawn.

E. Rejection of Claim 31

Claim 31 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hassell*. Applicants respectfully traverse this rejection.

It is asserted in the Office Action that *Hassell* anticipates each and every limitation of claim 1. *Office Action, p. 11.* Applicants respectfully disagree with this assertion. More specifically, *Hassell* does not disclose, teach or suggest that a processor is "configured to receive downloaded recordable media content characterizing information and downloaded recordable media content and to concurrently store the downloaded recordable media content into at least one of the portable mediums according to a processor determined correlation of the downloaded recordable media content characterizing information and characterizing information corresponding to the at least one of the portable mediums," as recited in independent claim 1.

Hassell appears to teach allowing "**the user to transfer programs ... stored on digital storage device 49** to other volumes of digital storage device 49 or to secondary storage device 47...." *Hassell, paragraph 81, lines 1-4. (Emphasis added.)* The

teaching, *arguendo*, appears to be the transfer of programs **stored**, or already recorded. There appears to be no discussion regarding the capability to download "recordable media content and to concurrently store the downloaded recordable media content" into portable mediums.

Thus *Hassell* fails to disclose, teach or suggest the features of independent claim 1. Because claim 31 contains the features of independent claim 1, Applicants respectfully submit that claim 31 is allowable as a matter of law.

In order to support the Official Notice, the Examiner provides Applicant U.S. Patent No. 5,619,247 to Russo. *Office Action, p. 12.* Applicants respectfully traverse this finding that the subject matter is well known. Particularly in the context of the claimed combination that includes a "processor, memory, and storage device located at the cable transmission facility," the subject matter alleged to be well-known is too specific and too complex for a reasonably skilled person to consider it to be well-known to the point that no additional evidence is needed.

In summary, it is Applicants' position that a *prima facie* case for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Berstis* in view of *Hassell* and that the rejection of these claims should be withdrawn.

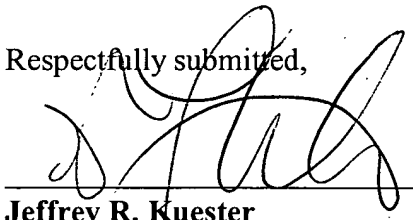
CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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